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10/655,162

09/04/2003

George A. Locko

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INTERNATIONAL PAPER COMPANY
6285 TRI-RIDGE BOULEVARD
LOVELAND, OH 45140

EXAMINER

ZEMEL, IRINA SOPJIA

ART UNIT

PAPER NUMBER

1711

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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3 MONTHS

03/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/655,162

Applicant(s)

LOCKO ET AL.

Examiner

Irina S. Zemel

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12-4-2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-32 and 36-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-32 and 36-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

Claim Rejections - 35 USC § 103

Claims 21-24 and 27-32 and 36-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lemmer of record in combination with Hawley's Condensed Chemical Dictionary, eleventh edition, page 1015, (hereinafter "Dictionary").

The rejection stands as per reasons of record.

Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lemmer in combination with the Dictionary as applied to claims 21 and further in combination with Irie of record.

The rejection stands as per reasons of record.

Insofar as the newly added limitations to the physical properties of the resins obtained by the claimed process, the Lemmer does not expressly address any of the claimed properties with the exception of the acid number which corresponds to the claimed acid number. However, it is reasonable believed that the resins obtained by the process disclosed in Lemmer necessarily inherently exhibit the claimed properties as they are obtained from the same reactants and via the substantially identical process (as claimed in the instant application, especially in the broad claims that have no reactant ratios). The burden is shifted to the applicants to provide factual evidence to the contrary. It is noted that none of the illustrative examples or the additional exhibits submitted by the applicants address or report any of the claimed physical properties. On the other hand, the specification broadly discloses the claimed properties without

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specifically connecting it to either the ratios of the reactants (as the specification discloses significantly broader ratios than those claimed in dependent claims), or any of the specific acids. Thus, the examiners believe that the disclosed resins inherently exhibit the claimed properties is reasonably supported by the facts.

Response to Arguments

Applicant's arguments filed 12-4-2006 have been fully considered but they are not persuasive. The applicant's arguments are directed to the fact that the reference does not disclose the claimed characteristics of the resin produced by the disclosed process. This argument is not convincing. The examiner agrees with the applicant's statement that the reference, Lemmer, does not expressly disclose the claimed physical properties of the resins, i.e., the claimed softening point, a Mw, a Mn, and a neat Gardner color. (the disclosed acid number of the resin, indeed, corresponds to the claimed characteristic). However, as discussed above, simply because the reference does not expressly address one of more physical characteristics of the disclosed product, it does not mean that the product does not inherently exhibit characteristics and properties corresponding to the claimed characteristics and properties. It has been long established by the case law that products of identical chemical composition can not have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). As discussed above, since the

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claimed process (especially in the broad claims that do not even have the reactants ratios) is identical to the process disclosed in the reference, it is reasonable believed that the claimed characteristics are necessarily exhibited by the disclosed products obtained from identical reactants under the same processing conditions as the claimed process. If this is not the case, then the applicants omitted some essential steps from the process that allow for production of the resin with the specified properties as compared to the product obtained by the process disclosed in the primary reference, in which case the claims do not comply with the provisions of 112, first paragraph.. Furthermore, there is absolutely no evidence on the record that any of the resins produced in illustrative examples exhibit such properties as none of the illustrative examples measures any of the claimed properties. On the other hand, the broad disclosure on page 3 of the instant specification generically discloses the claimed properties, but does not relate it to any specific process parameter outside of those that are already expressly disclosed in the Lemmer reference. This further supports the examiner's reasonable belief that the resins disclosed by Lemmer inherently exhibit the claimed properties. In the absence of showing clear evidence to the contrary, it is reasonable believed that the newly added limitations to the resin properties must be inherent in the disclosed product.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Irina S. Zemel

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Primary Examiner
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ISZ

A handwritten signature in black ink, appearing to read "M. J. Fennell", is written over the printed name of the Primary Examiner.